

Atty. Dkt. No. 044829-0118
U.S. Ser. No. 10/016,054

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: William F. McDonald et al.
Title: ANTIMICROBIAL POLYMER
Appl. No.: 10/068,054
Filing Date: 02/05/2002
Examiner: Channavajjala, Lakshmi Sarada
Art Unit: 1615

TERMINAL DISCLAIMER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Your Petitioner, Michigan Biotechnology Institute, having its principal place of business at 3900 Collins Road, Lansing, Michigan 48909, represents that it is the owner of the entire right, title, and interest in and to U.S. Patent Application Serial No. 10/068,054, (hereinafter "the '054 Application"), filed 02/05/2002, by virtue of an Assignment filed and recorded on 07/30/2003, on Reel/Frame 014339/0085, in the United States Patent and Trademark Office, a copy of which is attached hereto as APPENDIX A. Further, your Petitioner represents that it is the owner of U.S. Patent No. 6,797,743, which issued on U.S. Patent Application No. 09/850,324, (hereinafter "the '324 Application"), filed May 7, 2001, by virtue of an Assignment filed and recorded on May 3, 2001, on Reel/Frame 011800/0416, in the United States Patent and Trademark Office, a copy of which is attached hereto as APPENDIX B. The '324 Application is a continuation-in-part of U.S. Patent Application Serial No. 09/698,619, filed October 27, 2000, and a continuation-in-part of U.S. Patent Application Serial No. 09/671,784, filed September 27, 2000.

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Your Petitioner, Michigan Biotechnology Institute, hereby disclaims the terminal part of the term of any patent granted on the '054 Application which would extend beyond the full statutory term, as shortened by any terminal disclaimer, of U.S. Patent 6,797,743, and hereby agrees that any patent so granted on the '054 Application shall be enforceable only for and during such period that the legal title to U.S. Patent 6,797,743 shall be the same as the legal title to any patent granted on the '054 Application, this agreement to run with any patent granted on the '054 Application and to be binding upon the grantee, its successors or assigns.

In making the above disclaimer, Petitioner does not disclaim any terminal part of any patent granted on the '054 Application, prior to the full statutory term of U.S. Patent 6,797,743 as defined in 35 U.S.C. §§ 154-156, in the event that U.S. Patent 6,797,743 expires for failure to pay a maintenance fee, is held unenforceable or is found invalid in a final judgment by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. § 1.321(a), has all claims canceled by a reexamination certificate or as a result of an interference proceeding, or is otherwise not deemed to provide the rights conveyed by 35 U.S.C. § 154, prior to the full statutory term of U.S. Patent 6,797,743 as defined in 35 U.S.C. §§ 154-156, except for the separation of legal title stated above. Further, Petitioner does not disclaim any terminal part of a patent granted on the '054 Application that would extend beyond the present termination of U.S. Patent 6,797,743, in the event that the termination of U.S. 6,797,743 is extended by virtue of compliance with the conditions for term extension of any present or future patent term extension or adjustment provisions of the patent law, including but not limited to 35 U.S.C. §§ 155, 155A or 156, and without waiving Petitioner's right to extend the term of a patent granted on the '054 Application to the extent provided by law.

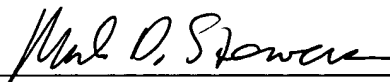
The undersigned, as President, certifies that he is empowered to sign this Terminal Disclaimer on behalf of the assignee, that he has reviewed the Assignments attached as APPENDICES A and B, and to the best of his knowledge and belief, legal title to the '054 Application and U.S. Patent 6,797,743 rests with Petitioner, Michigan Biotechnology Institute. The undersigned declares that all statements made herein of his own

knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the '054 Application or any patent issuing therefrom.

Executed this 18th day of January, 20 .

For: MICHIGAN BIOTECHNOLOGY INSTITUTE

By:



(Signature)

Mark D. Stowers

(Printed Name)

President

(Title)

APPENDIX A

ASSIGNMENT AND AGREEMENT

WHEREAS, Zhi-Heng Huang, 1470 Creekside Drive, Apt. 16, Walnut Creek, CA 94596 (hereinafter referred to as "ASSIGNOR"), together with **William F. McDonald**, 20750 Bell Church Rd., Utica, OH 43080, and **Stacy C. Wright**, 1707 Goat Rock Road, Fortson, GA 31808, have invented a certain invention entitled **ANTIMICROBIAL POLYMER** for which an application for United States Letters Patent was filed on February 5, 2002 as Application No. 10/068,054; and

WHEREAS, Michigan Biotechnology Institute, a corporation duly organized and existing under the laws of the State of Michigan, and having its place of business at 3900 Collins Road, Lansing, MI 48909 (hereinafter referred to as "ASSIGNEE") is desirous of acquiring ASSIGNOR's entire interest therein;

NOW THEREFORE, in consideration of One Dollar (\$1.00) and other good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, ASSIGNOR has sold, assigned, and transferred, and by these presents hereby sells, assigns, and transfers, unto ASSIGNEE, its successors and assigns, ASSIGNOR's entire right, title, and interest in and to (a) the above-identified invention or inventions and all improvements and modifications thereof, (b) the above-identified applications and all other applications for Letters Patent of the United States and countries foreign thereto for the above-identified invention or inventions and all improvements and modifications thereof, (c) all Letters Patent which have issued or may issue from said applications in the United States and countries foreign thereto, (d) all divisions, continuations, reissues, and extensions of said applications and Letters Patent, and (e) the right to claim for any of said applications the full benefits and priority rights under the International Convention and any other international agreement to which the United States adheres; such right, title, and interest to be held and enjoyed by ASSIGNEE, its successors and assigns, to the full end of the term or terms for which any and all such Letters Patent may be granted as fully and entirely as would have been held and enjoyed by ASSIGNOR had this Assignment not been made.

ASSIGNOR HEREBY AUTHORIZES AND REQUESTS the Commissioner of Patents and Trademarks to issue said Letters Patent to ASSIGNEE as assignee of ASSIGNOR's entire interest, for the sole use and benefit of ASSIGNEE, its successors and assigns.

ASSIGNOR HEREBY AGREES (a) to communicate to ASSIGNEE, its successors and assigns, or their representatives or agents, all facts and information known or available to ASSIGNOR respecting said invention or inventions, improvements, and modifications including evidence for interference, reexamination, reissue, opposition, revocation, extension, or infringement purposes or other legal, judicial, or administrative proceedings, whenever requested by ASSIGNEE; (b) to testify in person or by affidavit as required by ASSIGNEE, its successors and assigns, in any such proceeding in the United States or a country foreign thereto; (c) to execute and deliver, upon request by ASSIGNEE, all lawful papers including, but not limited to, original, divisional, continuation, and reissue applications, renewals, assignments, powers of attorney, oaths, affidavits, declarations, depositions; and (d) to provide all reasonable assistance to ASSIGNEE, its successors and assigns, in obtaining and enforcing proper title in and protection for said invention or inventions, improvements, and modifications under the intellectual property laws of the United States and countries foreign thereto.

ASSIGNOR HEREBY REPRESENTS AND WARRANTS that ASSIGNOR has the full and unencumbered right to sell, assign, and transfer the interests sold, assigned, and transferred herein, and that ASSIGNOR has not executed and will not execute any document or instrument in conflict herewith.

ASSIGNOR HEREBY GRANTS to the law firm of **Foley & Lardner** the power and authority to insert in this Assignment any further identification which may be necessary or desirable to comply with the rules of the U.S. Patent and Trademark Office for recordation of this Assignment.

ASSIGNOR UNDERSTANDS AND AGREES that the attorneys and agents of the law firm of **Foley & Lardner** do not personally represent ASSIGNOR or ASSIGNOR's legal interests; because said attorneys and agents cannot provide legal advice to ASSIGNOR with respect to this Assignment, ASSIGNOR acknowledges its right to seek its own independent legal counsel.

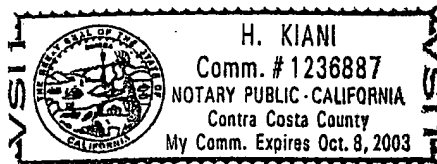
Executed this 29 day of May, 2003

State of California
County of Contra Costa) ss.

Zhi Heng-Huang
Zhi Heng-Huang

On this 29th day of May, 2003, before me, a notary public in and for said county, appeared Zhi Heng-Huang, who is personally known to me to be the same person whose name is subscribed to the foregoing instrument, and he/she acknowledged that he/she signed, sealed, and delivered the said instrument as his/her free and voluntary act for the uses and purposes therein set forth.

(Seal)



H. Kiani
Notary Public
My Commission Expires: Oct. 8, 2003

ASSIGNMENT AND AGREEMENT

WHEREAS, William F. McDonald, 20750 Bell Church Rd., Utica, OH 43080, and Stacy C. Wright, 1707 Goat Rock Road, Fortson, GA 31808, (hereinafter referred to singly and collectively as "ASSIGNOR"), together with Zhi-Heng Huang, 2225 Tahiti Dr., San Ramon, CA 94583 have invented a certain invention entitled **ANTIMICROBIAL POLYMER** for which an application for United States Letters Patent was filed on February 5, 2002 as Application No. 10/068,054; and

WHEREAS, Michigan Biotechnology Institute, Inc., a corporation duly organized and existing under the laws of the State of Michigan, and having its place of business at 3900 Collins Road, Lansing, MI 48909 (hereinafter referred to as "ASSIGNEE") is desirous of acquiring ASSIGNOR's entire interest therein;

NOW THEREFORE, in consideration of One Dollar (\$1.00) and other good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, ASSIGNOR has sold, assigned, and transferred, and by these presents hereby sells, assigns, and transfers, unto ASSIGNEE, its successors and assigns, ASSIGNOR's entire right, title, and interest in and to (a) the above-identified invention or inventions and all improvements and modifications thereof, (b) the above-identified applications and all other applications for Letters Patent of the United States and countries foreign thereto for the above-identified invention or inventions and all improvements and modifications thereof, (c) all Letters Patent which have issued or may issue from said applications in the United States and countries foreign thereto, (d) all divisions, continuations, reissues, and extensions of said applications and Letters Patent, and (e) the right to claim for any of said applications the full benefits and priority rights under the International Convention and any other international agreement to which the United States adheres; such right, title, and interest to be held and enjoyed by ASSIGNEE, its successors and assigns, to the full end of the term or terms for which any and all such Letters Patent may be granted as fully and entirely as would have been held and enjoyed by ASSIGNOR had this Assignment not been made.

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ASSIGNOR HEREBY AGREES (a) to communicate to ASSIGNEE, its successors and assigns, or their representatives or agents, all facts and information known or available to ASSIGNOR respecting said invention or inventions, improvements, and modifications including evidence for interference, reexamination, reissue, opposition, revocation, extension, or infringement purposes or other legal, judicial, or administrative proceedings, whenever requested by ASSIGNEE; (b) to testify in person or by affidavit as required by ASSIGNEE, its successors and assigns, in any such proceeding in the United States or a country foreign thereto; (c) to execute and deliver, upon request by ASSIGNEE, all lawful papers including, but not limited to, original, divisional, continuation, and reissue applications, renewals, assignments, powers of attorney, oaths, affidavits, declarations, depositions; and (d) to provide all reasonable assistance to ASSIGNEE, its successors and assigns, in obtaining and enforcing proper

title in and protection for said invention or inventions, improvements, and modifications under the intellectual property laws of the United States and countries foreign thereto.

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ASSIGNOR UNDERSTANDS AND AGREES that the attorneys and agents of the law firm of **Foley & Lardner** do not personally represent ASSIGNOR or ASSIGNOR's legal interests; because said attorneys and agents cannot provide legal advice to ASSIGNOR with respect to this Assignment, ASSIGNOR acknowledges its right to seek its own independent legal counsel.

Executed this 14th day of FEBRUARY, 2003.

William F. McDonald
William F. McDonald

State of Michigan
County of Eaton ss. Acting in my own capacity

On this 14th day of February, 2003, before me, a notary public in and for said county, appeared William F. McDonald, who is personally known to me to be the same person whose name is subscribed to the foregoing instrument, and he/she acknowledged that he/she signed, sealed, and delivered the said instrument as his/her free and voluntary act for the uses and purposes therein set forth.

Deborah Love
Notary Public

My Commission Expires: 9/20/06

(Seal)

DEBORAH LOVE
NOTARY PUBLIC EATON CO., MI
MY COMMISSION EXPIRES Sep 20, 2006

Executed this _____ day of _____, 20____.

Stacy C. Wright

State of _____)
County of _____) ss.

On this _____ day of _____, 20____, before me, a notary public in and for said county, appeared Stacy C. Wright, who is personally known to me to be the same person whose name is subscribed to the foregoing instrument, and he/she acknowledged that he/she signed, sealed, and delivered the said instrument as his/her free and voluntary act for the uses and purposes therein set forth.

Notary Public

My Commission Expires: _____

(Seal)

ASSIGNMENT AND AGREEMENT

WHEREAS, William F. McDonald, 20750 Bell Church Rd., Utica, OH 43080, and Stacy C. Wright, 1707 Goat Rock Road, Fortson, GA 31808, (hereinafter referred to singly and collectively as "ASSIGNOR"), together with Zhi-Heng Huang, 2225 Tahiti Dr., San Ramon, CA 94583 have invented a certain invention entitled **ANTIMICROBIAL POLYMER** for which an application for United States Letters Patent was filed on February 5, 2002 as Application No. 10/068,054; and

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NOW THEREFORE, in consideration of One Dollar (\$1.00) and other good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, ASSIGNOR has sold, assigned, and transferred, and by these presents hereby sells, assigns, and transfers, unto ASSIGNEE, its successors and assigns, ASSIGNOR's entire right, title, and interest in and to (a) the above-identified invention or inventions and all improvements and modifications thereof, (b) the above-identified applications and all other applications for Letters Patent of the United States and countries foreign thereto for the above-identified invention or inventions and all improvements and modifications thereof, (c) all Letters Patent which have issued or may issue from said applications in the United States and countries foreign thereto, (d) all divisions, continuations, reissues, and extensions of said applications and Letters Patent, and (e) the right to claim for any of said applications the full benefits and priority rights under the International Convention and any other international agreement to which the United States adheres; such right, title, and interest to be held and enjoyed by ASSIGNEE, its successors and assigns, to the full end of the term or terms for which any and all such Letters Patent may be granted as fully and entirely as would have been held and enjoyed by ASSIGNOR had this Assignment not been made.

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title in and protection for said invention or inventions, improvements, and modifications under the intellectual property laws of the United States and countries foreign thereto.

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Executed this _____ day of _____, 20__.

William F. McDonald

State of _____)
County of _____) ss.

On this _____ day of _____, 20____, before me, a notary public in and for said county, appeared William F. McDonald, who is personally known to me to be the same person whose name is subscribed to the foregoing instrument, and he/she acknowledged that he/she signed, sealed, and delivered the said instrument as his/her free and voluntary act for the uses and purposes therein set forth.

Notary Public

My Commission Expires:

(Seal)

Executed this 20 day of February, 2003

Stacy C. Wright
Stacy C. Wright

State of Georgia)
County of DuSable) ss.

On this 20th day of February, 2003, before me, a notary public in and for said county, appeared Stacy C. Wright, who is personally known to me to be the same person whose name is subscribed to the foregoing instrument, and he/she acknowledged that he/she signed, sealed, and delivered the said instrument as his/her free and voluntary act for the uses and purposes therein set forth.

Donna K. Morgan
Notary Public

My Commission Expires: 8/5/03

(Seal)

APPENDIX B

ASSIGNMENT

WHEREAS, WE, William F. McDonald of Utica, OH, Stacy C. Wright of Flint, MI, and Andrew C. Taylor of Ann Arbor, MI have made certain inventions which are described in an application for Letters Patent of the United States entitled ANTIMICROBIAL POLYMER executed by us on even dates herewith preparatory to obtaining United States Letters Patent therefor, and

WHEREAS, Michigan Biotechnology Institute, at 3900 Collins Road, Lansing, Michigan, 48910 is desirous of acquiring the entire right, title, and interest in and to said invention and in and to any Letters of Patent that may be granted therefor;

NOW, THEREFORE, in consideration of the sum of One Dollar, to us paid, the receipt of which is hereby acknowledged, we, William F. McDonald, Stacy C. Wright, and Andrew C. Taylor, by these presents do sell, assign, and transfer unto Michigan Biotechnology Institute, its successors and assigns to the full, exclusive, and world-wide right to the said invention and the entire right, title, and interest in and to any Letters Patent which may be granted therefor in the United States, in the territorial possessions of the United States, and in any country foreign to the United States, the same to be held and enjoyed by Michigan Biotechnology Institute and its successors and assigns as fully and entirely as the same would have been held by us had this assignment and sale not been made.

And we do hereby authorize and request the Commissioner of Patents and Trademarks of the United States and the Patent Office officials in countries foreign to the United States to issue said Letters Patent to Michigan Biotechnology Institute as the assignee of our entire right, title and interest in, to, and under the same, and we hereby further authorize said Michigan Biotechnology Institute to apply for Letters Patent in our names or in its own name, as it in its sole discretion sees fit, utilizing any benefits which may exist under any International Arrangement, in any country foreign to the United States.

And we hereby agree for ourselves and for our heirs, executors, and administrators to execute any lawful document and to testify as to any material fact or thing which Michigan Biotechnology Institute and its successors and assigns may deem necessary in order to secure unto itself, its successors and assigns the full right, title, and interest in and to and the full enjoyment of said invention or any part thereof and the said Letters Patent or any of them, the same to be done without any further consideration, provided however, that if we should be asked to testify in any legal proceeding to aid Michigan Biotechnology Institute in obtaining or enforcing patent protection for said invention while not employed by Michigan Biotechnology Institute we shall be entitled to reimbursement for reasonable costs and expenses.

IN WITNESS WHEREOF I hereby set my hand and affix my seal this 3rd day of May, 2001.

William F. McDonald (SEAL)
William F. McDonald

WITNESS: [Signature]
Claudian Payne

STATE OF MICHIGAN)
) SS
COUNTY OF Ingham)

On the day and year aforesaid, before me personally appeared William F. McDonald, to me known and known to me to be the person described in and the person who executed the foregoing instrument of assignment and he did acknowledge the same to be his free act and deed.

Claudian Payne
Notary Public, State of Michigan

My Commission: 11/20/02

CLAUDIEN PAYNE
Notary Public, Ingham County, MI
My Commission Expires 11/20/2002

(SEAL)

IN WITNESS WHEREOF I hereby set my hand and affix my seal this 3 day of May, 2001.

Stacy C. Wright (SEAL)
Stacy C. Wright

WITNESS:

[Signature]
Claudien Payne

STATE OF MICHIGAN)
) SS
COUNTY OF Ingham)

On the day and year aforesaid, before me personally appeared Stacy C. Wright, to me known and known to me to be the person described in and the person who executed the foregoing instrument of assignment and she did acknowledge the same to be her free act and deed.

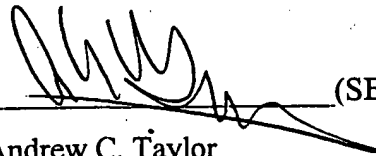
Claudien Payne
Notary Public, State of Michigan

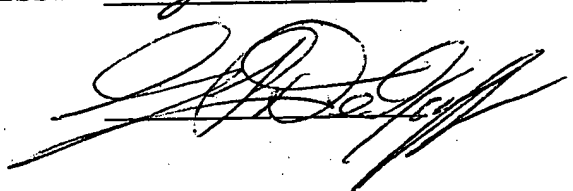
My Commission: 11/20/02

CLAUDIEN PAYNE
Notary Public, Ingham County, MI
My Commission Expires 11/20/2002

(SEAL)

IN WITNESS WHEREOF I hereby set my hand and affix my seal this 1st day of May, 2001.

 (SEAL)
Andrew C. Taylor

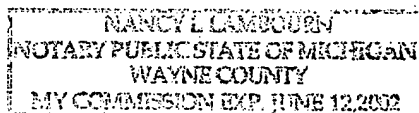
WITNESS: Nancy L. Lambourn


STATE OF MICHIGAN)
) SS
COUNTY OF Washtenaw

On the day and year aforesaid, before me personally appeared Andrew C. Taylor, to me known and known to me to be the person described in and the person who executed the foregoing instrument of assignment and he did acknowledge the same to be his free act and deed.

Nancy L. Lambourn
Notary Public, State of Michigan

My Commission: 6-12-02



(SEAL)

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